

## REMARKS

### Status of Claims:

Claims 1 and 2 – 24 are pending.

Claims 1 and 3 – 24 are rejected.

No claims are amended, cancelled or added by this response.

### Claim Rejections:

#### *Anticipation*

Examiner rejected claims 1, 3 - 4, 9 – 14, 17 and 19-23 as being anticipated by U.S. Patent No. 6,594,690 to Cantwell (the “690 patent”) under 35 USC § 102 (e). This rejection is respectfully traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” MPEP § 2131 citing *Continental Can Co. USA v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Examiner asserts that the ‘690 patent discloses the limitations “destination selection system to enable said user to select a location from said browser for saving

said scanning data" recited in claim 1. In particular, Examiner asserts that such limitations are disclosed at the following excerpt of the '690 patent:

The executable code uses the information about the device to select 30 a driver from the device. If more than one driver exists for the device, the executable code may either select 30 the best driver for the device or provide a list to the user for the user to select 30 a driver.

Once the driver has been selected 30, the driver is downloaded 32 from the driver website and installed 34 on the client (computer 4). If necessary, the executable code also configures 36 the driver so that it functions properly with the client's hardware and software configuration. ['690 patent, col. 3, ll. 3 – 12]

Assignee respectfully submits that the above quoted portion of the '690 patent does not disclose, suggest or make obvious, either expressly or inherently, selection of ***location for saving scanning data*** as advanced by Examiner. To the extent that Examiner believes that such disclosure is inherent, Assignee respectfully requests that Examiner cite documents showing that selection of ***location for saving scanning data*** is necessarily present in the '690 patent. In the absence of such citation, Assignee respectfully requests withdrawal of rejection of claims 1, and claims 3 - 4, 9 – 11 and 21 depending therefrom, under 35 USC § 102 (e).

Claims 12 – 14, 17, 19 and 20 recite limitation similar to those in claim 1 discussed above. Accordingly, in the absence of citation of documents showing that ***location for saving scanning data*** is necessarily present in the '690 patent, Assignee respectfully requests withdrawal of rejection of these claims under 35 USC § 102 (e).

***Obviousness***

Examiner also rejected claims 5-8, 15, 16 and 18 as being made obvious by the '690 patent, further in view of U.S. Patent No. 6,785,805 to House et al. (the "805 patent") under 35 USC § 103 (a). This rejection is respectfully traversed.

The '805 patent appears to relate to network-based methods for configuring and building integrated systems. However, the '805 patent does not appear to disclose, suggest or make obvious ***selection of a location for saving scanning data*** as set forth in claim 1. Accordingly, Assignee respectfully submits that the '805 patent does not make up for the deficiency of the '690 patent in meeting the limitations of claims 5-8, and respectfully requests withdrawal of the rejection of these claims under 35 USC § 103 (a).

Claims 12 and 17 recite limitations similar to those discussed above. Accordingly, Assignee respectfully submits that the '805 patent does not make up for the deficiencies of the '690 patent in meeting the limitations of claim 12, and respectfully requests withdrawal of dependent claims 15, 16 and 18 under 35 USC § 103 (a).

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In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. However, if the Examiner finds an reason why this application is not in condition for allowance, Applicants request that the Examiner contact the undersigned attorney by telephone at (503) 439-6500 to discuss the application.

Respectfully submitted,

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